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Date: December 29, 2008

Signed: *Janet M. Brown*

PATENT

Paper No.

File: Greene-USP1-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor	:	REES, Frank, L.
Serial No.	:	10/580,358
International Application No.	:	PCT/US2004/039909
Filed	:	November 25, 2004
For	:	GAUSS-REES PARAMETRIC ULTRA WIDEBAND SYSTEM
Group Art Unit	:	3662
Examiner	:	LOBO, Ian J.

MS: Fee Amendment
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION / ELECTION REQUIREMENT

SIR:

In response to the Office Action mailed 25 June 2008, please reconsider the application in view of the remarks set forth below.

As an initial matter, the Examiner's attention is drawn to the US application Ser. No. 10/722,648, which the PCT application claims priority, and which in turn forms the parent of the instant application. The Examiner is of record in US application Ser. No. 10/722,648 and should note corresponding claims on appeal. Should the Examiner issue a provisional double patenting rejection, Applicant will respond when any such rejection is made in a non-provisional way.

Turning now to the Office Action, the Examiner has issued a restriction requirement directed to requiring election of species and sub-species. In response, Applicant elects Group V corresponding to the generic claims 1, 115, 116, and 230. Applicant cannot discern from the vague restriction requirement exactly what dependent claim corresponds to the species or subspecies contemplated by the Examiner in his issuance of the Office Action. For this reason, Applicant has no choice but to proceed only with what is set out as the generic claims, 1, 115, 116, and 230. Pursuant to 35 USC Sec. 132 and Rule 104, the Examiner is required to provide information as to what dependent claims he has in mind in the requirement.

In any case, the restriction requirement is completely improper, and reconsideration is requested. This is a U.S. National patent application based on a PCT application. As such, 35 U.S.C. Sec. 372 must be applied, and it has not been applied. Thus, the restriction requirement is completely defective.

Further, pursuant to 35 U.S.C. Sec. 372 (2) "the Director may cause the question of unity of invention to be reexamined under section 121 of this title, *within the scope of the requirements of the treaty and the Regulations*" (emphasis added). Unity of invention is governed by PCT Rule 13.1, which pertains to whether inventions are linked as to form a single general inventive concept, which the Examiner has conceded by repeatedly stating in the Restriction Requirement that "claims 1, 115, 116, and 230 appear to be generic." There is unity of invention.

Unity of invention is also evidenced by the PCT examination of the parent application, where the Examiner issued the exact same restriction requirement, which was reversed by PCT Legal in response to Applicant's Protest. That decision and its papers are believed to be in the National Application file and are incorporated here by reference. The attempted specie restriction in the National application is as improper now as it was in error in the PCT case.

Further, there is no such thing as specie sub-specie where there is unity of invention in a PCT National case. The Examiner has not even alleged lack of unity of invention, let alone made a showing of it. This restriction requirement is completely defective.

Second, the restriction requirement is improper pursuant to 35 U.S.C. Sec. 132 which requires "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". There is nothing but allegation to support the Restriction Requirement, and this is contrary to MPEP Sec. 809, which requires the Examiner to "provide reasons why the species are independent or distinct." If the restriction requirement is maintained, Applicant respectfully requests (1) the reasons and (2) the information, both of which are required by 35 U.S.C. Sec. 132. The present Office Action is nothing more than Examiner contention, which is insufficient under Sec. 132 and Rule 104, and wholly improper for a PCT National case with unity of invention.

Third, 35 U.S.C. Sec. 121 applies to inventions that are separate and distinct. The Office Action does not contend or properly establish that any of the groups is separate and distinct and has separate utility, as is required pursuant to MPEP Sec. 802. Again, the present Office Action is nothing more than Examiner contention, which is insufficient under Sec. 132 and Rule 104.

Fourth, the Office Action does not contend or properly establish that any of the sub-species is separate and distinct and has separate utility, as is required pursuant to MPEP Sec. 802.

The MPEP states, with emphasis added:

808.01 Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.

Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth.

The restriction requirement in the Office Action does not comply with this section of the MPEP.

Fifth, even if the species and sub-species are each established as separate and distinct, there is "a serious burden on the Examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02)." And pursuant to GUIDELINES found there, "examiners must provide reasons and/or examples to support conclusions." The Examiner has not provided sufficient "reasons and/or examples to support conclusions" as required by the MPEP.

Issuing a restriction requirement contrary to PCT rules governing unity of invention is clear error and consistent with history of this patent application family, where the Examiner has repeatedly and erroneously sought to avoid proper examination of the claims. The restriction requirement is completely improper, and if this present restriction requirement is not withdrawn on the next Office Action, Applicant will immediately petition this issue.

APPLICANT CLAIMS SMALL ENTITY STATUS The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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Date: December 28, 2008

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